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10/723,535	11/26/2003	Uwe Klinger	16104-015001 / 2003P00897	8674
32864	7590	10/03/2007	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			LEE, JINHEE J	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/723,535

Applicant(s)

KLINGER, UWE

Examiner

Jinhee J. Lee

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16-19 and 21-61 is/are pending in the application.
- 4a) Of the above claim(s) 23-59 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-19, 21, 22 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 23-59 and 61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in Paper Dated 2/15/07.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13, 16-19, 21-22, 60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new matter is as follows:

“Determining whether the server device has specified a request” and “back function and the forward function...the request instructing the server device to change the application program from the first state to a second state” (Page 7 in the specification states that the client device may continue displaying the application page).

4. Claims 1-13, 16-19, 21-22, 60 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The limitation that the client service may continue displaying the application page depending on the ability of the program to undo

the request which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-13, 16-19, 21-22, 60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of :

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Claims 1-13, 16-19, 21-22, 60 are directed to a computer implemented method of calculation where the inputs are numbers and the results are also numbers, and/or are directed to a computer program stored in a computer readable storage medium for implementing the method. In order for a claimed invention that is directed to such a computer implemented method of calculation, or a computer program stored in a computer readable storage for implementing a computation to be statutory, the claimed invention must accomplish a practical application. That is the claimed invention must transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result. *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

It is clear from claims 1-13, 16-19, 21-22, 60 that the claims merely involve calculations and manipulations of data in performing computations. The claimed invention does not result in a physical transformation. The inputs are numbers and the

outputs are also numbers. The result of the invention is merely numerical values without a practical application recited in the claims. It is not real world result, and thus is not useful, concrete and tangible. Therefore, the claimed invention is directed to non-statutory subject matter as the claims fail to assert a practical application to the invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-13, 16-19, 21-22, 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 60 recite the limitation "server device has specified a request", this is confusing. Applicant's specification discloses that the user specifies the request and the server receives the request. Clarify.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2174

10. Claims 1-13, 16-19, 21-22, 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Slotznick (6011537).

Re claim 1 (as best understood), Slotznick discloses a method of providing navigation in a browser, the method comprising:

displaying an application page in a browser on a client device, the application page being received from a server device and relating to a first state of an application program on the server device, the browser having a back function and a forward function (see column 18 lines 11-14 according to the numbering in the middle and column 37 lines 24-25 for example);

receiving an input from a user while the application page is being displayed, the input requesting one of the back function and the forward function (see column 37 lines 24-25 for example);

determining whether the server device has specified a request as being associated with the requested one of the back function and the forward function for the application page, the request instructing the server device to change the application program from the first state to a second state (see column 37 lines 24-25 for example); and

generating the request to the server device (inherent) in response to receiving the input if the request has been specified, else not requesting a change to the first state in response to the input (see column 18 lines 11-14 and abstract for example).

Re claim 2, Slotznick discloses a method, further comprising loading at least one invisible page in the browser such that the application page is visible in the browser

after the at least one invisible page has been loaded (see column 15 lines 5-6, lines 14-20, lines 32-36 for example).

Re claim 3, Slotznick discloses a method, wherein loading the at least one invisible page comprises loading a first invisible page and then a second invisible page in the browser (different secondary information for example, see column 16 lines 15-18).

Re claim 4, Slotznick discloses a method, further comprising again loading the first invisible page if the input requests the back function (column 17 lines 47 and lines 54-59 for example).

Re claim 5, Slotznick discloses a method, wherein again loading the first invisible page triggers generation of the request (column 15 lines 5-6, lines 14-20, lines 32-36 for example).

Re claim 6, Slotznick discloses a method, further comprising storing information in a cookie on the client device to identify that the first invisible page is again being loaded in response to receiving the input requesting the back function (see column 15 lines 41-44, column 16 lines 29-33 for example).

Re claim 7, Slotznick discloses a method, further comprising activating the back function after loading the second invisible page and again loading the first invisible page (column 17 lines 47, lines 54-59 for example).

Re claim 8, Slotznick discloses a method, further comprising again loading the second invisible page if the input requests the forward function (column 37 lines 24-25 for example).

Re claim 9, Slotznick discloses a method, wherein again loading the second invisible page triggers generation of the request (column 16 lines 15-20 and column 37 lines 24-25 for example).

Re claim 10, Slotznick discloses a method, further comprising storing information in a cookie on the client device to identify that the second invisible page is again being loaded in response to receiving the input requesting the forward function (column 15 lines 41-44, column 16 lines 29-33 for example).

Re claim 11, Slotznick discloses a method, further comprising loading a third invisible page in the browser after loading the second invisible page and activating the back function after loading the third invisible page and again loading the second invisible page (column 16 lines 15-20 for example).

Re claim 12, Slotznick discloses a method, further comprising: again loading the first invisible page if the input requests the back function; and again loading the third invisible page if the input requests the forward function (column 16 lines 15-20, c37 lines 24-25 for example).

Re claim 13, Slotznick discloses a method, wherein generation of the request is triggered by again loading one of the first and third invisible pages (column 16 lines 15-20 for example).

Re claim 16, Slotznick discloses a method, wherein the request comprises that a measure taken on the server device be undone (inherent function of forward and backward for example, see column 37 lines 24-25).



Re claim 17, Slotznick discloses a method, wherein the request comprises that a measure taken on the server device that has been undone should be redone (see column 37 lines 24-25 for example).

Re claim 18, Slotznick discloses a method, wherein the request is for the server device to provide a second application page to the client device (column 16 lines 15-18 for example).

Re claim 19, Slotznick discloses a method, wherein upon determining that the request has not been specified, the method further comprises continuing to display the application page (column 18 lines 11-14 and abstract for example).

Re claim 22, Slotznick discloses a method, wherein the application page is received from the server device in response to a request sent from the client device (column 18 lines 11-14 for example).

Re claim 60, Slotznick discloses a computer program product containing executable instructions that when executed cause a processor to perform operations comprising:

displaying an application page in a browser on a client device, the application page being received from a server device and relating to a first state of an application program on the server device (inherent), the browser having a back function and a forward function (see column 18 lines 11-14 and column 37 lines 24-25 for example);

receiving an input from a user while the application page is being displayed, the input requesting one of the back function and the forward function (column 37 lines 24-25 for example);

determining whether the server device has specified a request as being associated with the requested one of the back function and the forward function for the application page, the request instructing the server device to change the application program from the first state to a second state (see column 37 lines 24-25 for example); and

generating the request to the server device in response to receiving the input if the request has been specified, else not requesting a change to the first state in response to the input (column 18 lines 11-14 and abstract for example).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slotznick in view of Li (7003695).

Re claim 21, Slotznick substantially discloses the method as set forth in claim 19 above. Slotznick does not explicitly disclose the method further comprising displaying a message to the user announcing one of an impossibility of undoing a measure taken on the server device and an impossibility of redoing a measure taken on the server device that has been undone. However, Li teaches of a method wherein a action further comprises displaying a message to the user announcing one of an impossibility of undoing a measure taken on the server device and an impossibility of redoing a

measure taken on the server device that has been undone (see claim 9 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the message of Li on the method of Slotznick in order to provide clear message of inability of the program.

### ***Response to Arguments***

13. Applicant's arguments filed 7/20/07 have been fully considered but they are not persuasive.

In response to applicant's arguments that 101 requirements are met, examiner disagrees. An apparatus claims need to have an hardware to establish a statutory category, and if the claims are for programmed functionality, then a physical transformation or a useful, concrete and tangible final result. Method claims likewise need a physical transformation or a useful, concrete and tangible final result. The claims are lacking in the requirements, therefore have not met the statutory requirement.

In response to applicant's arguments that the Slotznick fails to disclose that a request changing an application state be specified by a server, examiner points out that the application states that "the server receives the request" by the user. Slotznick discloses user specifying the instruction as disclosed by the applicant. Therefore, the claims have been interpreted as such in order to reject as best understood.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-2100 ext. 74. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jinhee J Lee  
Primary Examiner  
Art Unit 2174

A handwritten signature in dark ink, appearing to read 'Jinhee J Lee', with a long horizontal flourish extending to the right.

jji